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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,480	03/27/2001	Ronald P. Sansone	E-986	9576

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EXAMINER	
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ART UNIT	PAPER NUMBER
3639	

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.

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Commissioner for Patents

The IDS of 1/23/06 has been considered.

Thomas A. Dixon
Primary Examiner
Art Unit: 3639

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/818,480
Filing Date: March 27, 2001
Appellant(s): SANSONE, RONALD P.

Ronald Reichman
26,796
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 January 2006 appealing from the Office action mailed 13 July 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Applications on appeal 09/818,792 and 09/817,998.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-34 are rejected are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (2002/0042808 or 2002/0095306) in view of Higgins (5,754,671).

Applicant has split the grounds of rejection into two rejections of:

Claims 1-4, 7, 10-12, 13, 18, 20, 24 and 28-34 under 103 to Smith et al in view of Higgins et al and

Claims 5, 8-9, 13-15, 19, 21-23, 25 and 26 under 103 to Smith et al in view of Higgins et al and

Overlooking claims 6, 16, 17, and 27.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0042808	SMITH et al	4-2002
2002/0095306	SMITH et al	7-2002
5,754,671	Higgins et al	5-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

9a Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (2002/0042808 or 2002/0095306) in view of Higgin's et al (5,754,671).

As per Claim 1:
Smith et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:
scanning the recipient's name and physical address and a sender's name and address (see Figs. 5-9 for the incoming mails and paragraphs (0022-0023) in 2002/0042808 for example);
capturing the name and address of the recipient and the sender in the form an image (see Figs. 5-8, 11 and the descriptions thereof, paragraph (0032);
translating the name and address of the recipient into an e-mail address (see

paragraph (0015) with respect to e-mail service;

notifying the recipient of the expected delivery of the mail (see paragraphs (0014), (0017-0023));

depositing with the carrier the mail;

notifying the data center of the manner in which the recipient wants the mail delivered (paragraphs (0022-00234)) and

delivering by the carrier mail to the recipient.

However, Smith et al. does not specifically disclose the method including: transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric', and indicating the selected alphanumeric of the translated image.

Higgins et al. is cited to show that the invention captures mail pieces in the form an image and translates the captured image into alphanumeric (for example, see Fig. 5 for the translation process, see Figs. 18-24 and the descriptions thereof).

Since both Higgins et al. and Smith et al. are both from the same field of endeavor of automatic mail processing, the purpose disclosed by Higgins et al. would have been well recognized in the pertinent art of Smith et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the mail piece scanning process (which could take much memory storage due to each image's large file size) with the simple process that transmits the captured image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric', and indicates the selected alphanumeric of the translated image, as taught by Higgins et al., for the purpose of providing an efficient and simple system that requires the less memory storage for each image file (just alphanumeric data) to save a significant amount of time and file size.

As per Claim 2:

The modified Smith et al. further discloses the method wherein the recipient is notified of the estimated arrival time (paragraphs 0015-0025).

As per Claim 3:

The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to a specified name and address (paragraphs (0015-0025)).

As per Claim 4:

The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to return the mail to the sender (see Id.).

As for Claims 5, 8-9, 13-15, 19, 21-23 and 25-26.

The modified Smith et al. discloses the method as cited above and further discloses the method including:

informing the carrier to e-mail the contents of the mail piece to the

recipient (see Supra Smith et al.);

mailing by e-mail the contents of mail piece (see Id.);

informing the carrier to e-mail the contents of the mail piece to one or more specified e-mail addresses (see Id.); and

mailing by e-mail to the specified e-mail address (paragraphs 0015-0023, 0033).

However, the modified Smith et al. does not specifically disclose the method including the limitations in Claims 5, 8-9, 13-15, 19, 21-23 and 25-26 (opening the mail, sending the information contents to PDA, using facsimile, how to charge, recycling the mail, telephoning, and notifying via television).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to arrange to open the mail, sending the information contents to PDA, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified method of Smith et al. because one of ordinary skill in the art may adopt other notification manners and incorporate them into the modified notification system of Smith et al...

Therefore, it would have been an obvious matter of design choice to further modify the modified invention of Smith et al. in view of Higgins et al. so as to obtain the invention as specified in claims 5, 8-9, 13-15, 19, 21-23 and 25-26.

As per Claims 6-7:

The modified Smith et al. discloses the method further including:

informing the carrier to e-mail the contents of the mail piece to the recipient (see Supra Smith et al. Figs. and paragraphs);

mailing by e-mail the contents of mail piece (se Id.);

informing the carrier to e-mail the contents of the mail piece to one or more specified e-mail addresses; and

mailing by e-mail to the specified e-mail address (paragraphs 0015-0023, 0033).

As per Claim 10:

The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address (see Supra Smith et al. paragraphs).

As per Claims 11-12:

The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one (see Supra Smith et al. paragraphs 0015-0023);

As per Claims 16-17:

The modified Smith et al. further discloses the method including: informing the sender of the delivery of the mail; and wherein the recipient notifies the carrier to hold the mail (see Id.).

As per Claim 18: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to destroy (or trash in Smith et al.) the mail (paragraph 0022).

As per Claim 20: The modified Smith et al. fudher discloses the method wherein the recipient is notified via e-mail (see Supra Smith et al.)

As per Claim 24:
The modified Smith et al. further discloses the method wherein the carrier is notified via e-mail (see Id.);

As per Claim 27:
The modified Smith et al. further. discloses the method wherein the recipient notifies a data center as to notify the carrier (see Supra Smith et al. paragraphs).

As per Claims 28-32
The modified Smith et al. further must include the mail inherently containing a stamp, a postal indicia, permit and symbology, and

As per Claims 33-34: The modified Smith et al. further discloses the method wherein the graphic is captured and translated and stored (see paragraph 0015, view "image").

(10) Response to Argument

10a In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The test of obviousness is what the combined teachings of the references would have suggested to those of ordinary skil! in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to appellant's argument that Smith et al. requires that the user print personal ID code and the ID code is captured by the post; and this same ID code be associated to any other postal data object, it is noted that the features upon which appellant asseds are not recited in the rejected claimts) and the modified method of Smith et al. does include the essential method steps of capturing', transmitting', translating; and notifying to enable a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail. Furthermore, the appellant never expressly claim a particular approach (e.g. using the user ID or not requiring the ID) to capture the mail piece to patentably distinguish from the prior ad. Accordingly, the difference between the appellant's invention and Smith et al. would be obvious.

In response to the appellant's argument that the examiner has not cited any art to indicate why it would be obvious to send the contents of the mail piece via different specified channels in the environment of claim 1 , 2002/0042808 discloses that communications between users of the system and the hardware components may use any form of electronic communication, such as direct wire, wireless, modems and the Internet, and therefore, it would have been obvious to utilize any type of electronic communication, such as TV, PDA or any other manners as claimed by the appellant.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decisions have been rendered in the Related Appeals and Interferences section listed in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Thomas A. Dixon
Primary Examiner

Conferees:

Dean Nguyen

John Weiss